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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Number: 5,745,838

Att'y Docket No.: 450-022PD

Issue Date: 04/28/1998

Patentee: Arrow Communication Laboratories, Inc.

Title: Return Path Filter

Application Number: 08/818,231

Inventors: Andrew F. Tresness and
Martin L. Zelenz

Filing Date: 03/14/1997

COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450

07/25/2006 TBESHAH1 00000026 5745838

SUBMISSION UNDER 37 C.F.R. § 1.28(c)

3940.00 OP

Dear Sir:

Patentee, Arrow Communication Laboratories, Inc., hereby submits payment of certain fees previously paid as a small entity in the above-identified application and patent. Enclosed are the following in connection with this submission:

1. Payment under 37 C.F.R. § 1.28(c)(2), in the form of a check in the amount of \$3,948.
2. Itemization Under 37 C.F.R. § 1.28(c)(2)(ii) (Exhibit A).
3. Proposed Amended Answer and Counterclaim of defendant, John Mezzalingua Associates, Inc. (Exhibit B)

The entire right, title and interest in and to the above-identified application was assigned to the Tresness Irrevocable Patent Trust ("Tresness Trust") by written assignment from the inventors executed on March 14, 1997, and recorded in the U.S. Patent and Trademark Office (USPTO) on March 14, 1997, at Reel/Frame 8466/0149. The entire right, title and interest in and to the above-identified patent was subsequently assigned to the current patentee, Arrow Communication Laboratories, Inc. ("ARCOM"), by written assignment executed by the Tresness Trust on June 2, 2005, *nunc pro tunc* as of January 1, 2004, and recorded in the USPTO on June

6, 2005, at Reel/Frame 016087/0650 and 016097/0231 (“Corrective Assignment”). The undersigned is authorized to act on behalf of Patentee, ARCOM, the current assignee of the above-identified patent.

ARCOM notes for the record that the small entity status of ARCOM and its predecessor in title, Tresness Trust, has been questioned in a litigation involving the above-identified patent. The litigation is entitled, Arrow Communication Laboratories, Inc. and Tresness Irrevocable Patent Trust v. John Mezzalingua Associates, Inc., Civil Action No. 05-CV-1456, currently pending in the U.S. District Court of the Northern District of New York (“the Litigation”).

The defendant in the Litigation, John Mezzalingua Associates, Inc. (“JMAI”), has alleged in its Proposed Amended Answer and Counterclaim (Exhibit B attached hereto) that representatives of the Tresness Trust, ARCOM, and an entity related to ARCOM, Arcom Automatics, LLC, during the prosecution of the above-identified patent application, and at the time the application and issue fees were due, and/or at the times the maintenance fees were paid, falsely and improperly claimed small entity status in connection with the above-identified application and patent. JMAI has further alleged, upon information and belief, that ARCOM had nearly 800 employees since at least 2002, and that the claims of small entity status were made with intent to deceive the PTO in order to pay reduced fees, knowing that the patent owners, including affiliates, had over 500 employees and/or had conveyed rights in the invention to other entities who did not qualify as small entities. JMAI has further alleged, based on the foregoing allegations, that the above-identified patent is unenforceable by reason of inequitable conduct and fraud upon the Patent Office. ARCOM and the Tresness Trust deny these allegations.

ARCOM wishes to avoid any question over small entity status. Accordingly, ARCOM submits payment and an Itemization under 37 CFR 1.28(c) (Exhibit A).


ARCOM also notes that JMAI has alleged in its Proposed Amended Answer and Counterclaim (Exhibit B) that the patent is unenforceable because of alleged inequitable conduct and fraud resulting from an alleged misrepresentation regarding a prior art technical article entitled, “Designing the Return System for Full Digital Services,” by Dean A. Stoneback and William F. Beck (a prior art reference disclosed by the Tresness Trust at the time of filing the above-identified application). ARCOM and the Tresness Trust also deny these allegations.

All of the above allegations are more fully set forth in JMAI's proposed Amended Answer and Counterclaim (Exhibit B). A similar pleading against the Tresness Trust has been proposed in the Litigation by JMAI.

If the Office requires further information or explanation, please do not hesitate to contact the undersigned.

Respectfully submitted,

7-20-06
Date


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ITEMIZATION OF PAYMENT UNDER 37 CFR 1.28(c)

U.S. PATENT 5,745,838 (Apr. 28, 1998)

<u>Type of Fee</u>	<u>Current Fee Amount</u>	<u>Small Entity Fee Paid</u>	<u>Date Paid</u>	<u>Difference</u>
Basic Filing Fee	\$ 790 ¹	\$ 385	03-14-1997	\$ 405
Ind. Claims > 3 = 2	400	80	03-14-1997	320
Claims > 20 = 22	1,100	242	03-14-1997	858
Issue Fee	1,400	660	01-27-1998	740
Maintenance Fee 3.5 Yr.	900	425	08-06-2001	475
Maintenance Fee 7.5 Yr.	2,300	1,150	06-07-2005	1,150
TOTAL				\$3,948

¹ Most current fee before change in fee structure, i.e., before December 8, 2004.